

REMARKS

Claims 20, and 23 to 37 of the subject application are currently pending. Of these claims, claims 20 and 23 to 30 have been allowed, whereas claims 31 to 37 have been rejected.

The Examiner has rejected claims 31 to 37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Further, the Examiner has rejected claims 31 to 37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. With regard to the rejections under 35 U.S.C. § 112, the Examiner argues that the limitation "*wherein the second shifter has a capacity to shift which is less than the maximum instruction length*" as recited in claims 31 to 37 constitutes new matter. Specifically, the Examiner argues that the above limitation of claims 31 to 37 was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. In response, the Examiner is referred to the specification of the subject application, at page 12 lines 10-15 where it is stated that an instruction has a maximum length of 11 bytes. The Examiner is also referred to Figure 5 of the drawings, where it is clearly shown that the shifter 506 is able shift bytes Len1-Len8 of the maximum 11 byte instruction which is shown to comprise bytes Len1 to Len11 in Figure 6b of the drawings. Furthermore, the shifter 506 in Figure 5 of the drawings is indicated with the label "8:1" which clearly indicates to one skilled in the art that the shifter 506 is able to shift by a shift value of one byte through to eight bytes. Thus, Figure 5 of the drawings makes it clear that the shifter 506 has a capacity to shift at most eight bytes, which is less than the maximum instruction length of 11 bytes. Based on the foregoing, it is respectfully submitted that the Examiner would agree that the limitation "*wherein the second shifter has a capacity to shift which is less than the maximum instruction length*" as recited in claims 31 to 37 does not constitute new matter.

With regard to the Examiner's rejection of claims 30 to 37 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, the Examiner argues that the limitation "*wherein the second shifter has a capacity to shift which is less than the maximum instruction length*" as recited in claims 31 to 37 is not enabled. Applicants however, respectfully disagree with the Examiner in this regard, and point out that one of ordinary skill in the art would

know how to make and/or use a *"second shifter that has a capacity to shift which is less than the maximum instruction length"*.

Based on the foregoing, the Examiner is respectfully requested to withdraw his rejection of claims 31 to 37 under 35 U.S.C. § 112, first paragraph as failing to comply with the written descriptions requirement, and as failing to comply with the enablement requirement.

Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 31-37 under 35 U.S.C. § 103(a) as being unpatentable over Colavin (US 5,666,115) in view of Riffe, et al in (US 4,502,111). Applicants traverse.

The Examiner argues that Colavin discloses the limitation *"wherein the second shifter has a capacity to shift which is less than the maximum instruction length"*, at column 6, lines 36 to 40. Further, the Examiner argues that the second barrel shift register 13 described in column 6, lines 36 to 40 has the potential or ability to shift *"at the most"* or *"less than"* the longest code. The Examiner argues that the word *"capacity"* indicates a potential or ability for accommodating (as defined in Merriam-Webster's Collegiate Dictionary). The Examiner states that *"according to column 6, lines 36-40 of Colavin, the shift register performs a shift of 'at most' including 'less than' the longest code. Clearly, from the cited passage, just because the shifter has the ability to shift the longest instruction does not mean that it does"*.

The applicants respectfully disagree with the Examiner in this regard. The Merriam-Webster's Collegiate Dictionary, referred to by the Examiner, defines the word *"capacity"* in a first sense to mean *"the potential or suitability for holding, storing or accommodating"* and in a second sense to mean *"the maximum amount or number that can be contained or accommodated"*. The dictionary also provides a sample usage of the word *"capacity"* in the second sense, e.g. a jug with a one gallon capacity. Dwelling on the sample usage provided by the dictionary for a moment, the Examiner will concede that even though a jug may have a capacity or maximum amount such that it can contain one gallon, the jug may very well actually contain less than one gallon. However, the fact that the jug contains less than one gallon does not alter the fact that the jug has a capacity of one gallon. When the word *"capacity"* in the limitation *"wherein the second shifter has a capacity to shift which is less than the maximum instruction length"* is accorded its normal dictionary meaning of *"the maximum number or amount that can be contained or accommodated"*, then it will be seen that a proper construction of the above limitation requires

that the second shifter be able to shift by a maximum amount which is less than the maximum instruction length. In other words, the second shifter cannot shift an instruction which has a length equal to the maximum instruction length since such an instruction would exceed its capacity to shift. Another way of looking at the word "*capacity*" is that it defines an upper limit on the ability of a shifter in terms of the instruction length that the shifter is able to shift. In the case of the second barrel shift register 13 described in Colavin, this barrel shifter has an upper limit or capacity that is equal to the length of the longest code. That is not to say that the second barrel shifter 13 cannot shift less than the longest code. Certainly, the second barrel shift register 13 of Colavin is able to shift instructions/code that is less than the maximum instruction length. However, the second barrel shift register 13 still has a capacity to shift which is equal to the maximum instruction length/code and not less than the maximum instruction length/code.

Viewed in another way, the limitation "*wherein the second shifter has a capacity to shift which is less than the maximum instruction length*" simply means that the second shifter is not able to shift an instruction which has an instruction length equal to the maximum instruction length. This is clearly in contrast with the barrel shift register 13 of Colavin, which is able to shift the longest code likely to present itself. In other words, the second barrel shift register 13 of Colavin is able to shift by an amount equal to the maximum instruction length, whereas the second shifter recited in the claim is not able to shift by an amount equal to the maximum instruction length.

In view of the foregoing, the Applicants respectfully request the Examiner to interpret the word "*capacity*" recited in claims 31 to 37 in accordance with its normal dictionary meaning, in which case, the Examiner will concede that the combination of Colavin and Riffe does not teach or suggest all limitations of claims 31 to 37.

Accordingly, the Examiner is respectfully requested to withdraw his rejection of claims 31 to 37.

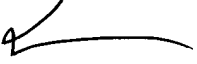
It is respectfully submitted that in view of the remarks set forth herein, all rejections have been overcome. All pending claims are now in condition for allowance, which is earnestly solicited.

If the Examiner determines that prompt allowance of these claims could be facilitated by telephone conference, the Examiner is invited to contact Vani Moodley at (408) 720-8300.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicants hereby request such an extension.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: 10/26, 2004



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